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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,765	09/07/2000	Jeremy S DeBonet	1116-119	1556

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EXAMINER	
TODD, GREGORY G	

ART UNIT	PAPER NUMBER
2457	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/656,765	DEBONET ET AL.	
	Examiner	Art Unit	
	GREGORY G. TODD	2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *39-47,49-53 and 55-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *39-47,49-53 and 55-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This office action is in response to applicant's amendment filed 02 December 2008, of application filed, with the above serial number, on 07 September 2000 in which claims 38, 48, and 54 have been cancelled and claims 39-47, 49-53, and 55-57 have been amended. Claims 39-47, 49-53, and 55-57 are pending in the application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 55-57 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to "a computer-usable medium". According to the October 26, 2005 Interim Guidelines for Examining Patent Applications, signal claims are ineligible for patent protection because they do not fall within the four statutory classes of § 101. (See http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does

not make it statutory. (See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 and See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978)).

Page 24 lines 6-7 of the specification identifies the medium to be a transmission medium/ wireless IP.

In order to expedite a comprehensive examination of the instant application, the claims rejected under 3 5 U.S.C. 101 (non- statutory) above, are further rejected as set forth below in anticipation of applicant amending these claims to place them within the admissible statutory categories of invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 39, 41, 43-46, 49, 52-53, 55, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Hitson et al (hereinafter “Hitson”, 2002/0010759).

As per Claim 39, Hitson teaches a method of operating a server to provide a customized broadcast comprising:

maintaining a user profile including information relating to a preference of a user

associated with the user profile (at least paragraph 54-55; user registration/ profile/ preferences);

maintaining a user listening history comprising a list identifying at least a portion of a plurality of broadcast elements previously transmitted to a user device (at least paragraph 139, 151; previously transmitted playlist providing feedback, adjusting preferences);

without selection from a user device, automatically selecting a plurality of broadcast elements comprising a song broadcast element and an advertising broadcast element based on the user profile and the user listening history (at least paragraph 11, 14, 90; advertisements and song/ playlists based on user preferences/ previous playlist); and transmitting the plurality of broadcast elements to the user device (at least paragraph 76; eg. listen now stream).

As per Claim 41. The method of claim 39 further comprising modifying the information in the user profile based on the plurality of broadcast elements that are selected automatically (at least paragraph 139, 151; adjusting preferences).

As per Claim 43. The method of claim 39 wherein the user profile includes information indicating a preference of a frequency of selection and transmission of a plurality of types of broadcast elements (at least paragraph 151; restricting frequency).

As per Claim 44. The method of claim 39 wherein the plurality of broadcast elements further comprise a personalized broadcast element that includes a reference to a name of a user associated with the user device (at least paragraph 75-76, 61, 69-70; username).

As per Claim 45. The method of claim 39 further comprising iteratively repeating without selection from the user device, automatically selecting and transmitting the plurality of broadcast elements to the user device (at least paragraph 44; continuous data stream).

As per Claim 46. The method of claim 39 wherein the plurality of broadcast elements are sequentially transmitted to the user device (at least paragraph 44; stream).

Claims 49, 52-53, 55, and 57 do not, in substance, add or define any additional limitations over claims 39, 41, and 43-46 and therefore are rejected for similar reasons.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 40, 42, 50, 51, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitson in view of Rosenberg et al (hereinafter "Rosenberg", 7,028,082).

As per Claim 40, Hitson fails to explicitly teach wherein the plurality of broadcast elements further comprise a weather broadcast element. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Rosenberg. Rosenberg teaches a personalized audio channel having personalized information such as weather

(at least col. 4:63-5:3). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Rosenberg's weather information with Hitson as this would enhance Hitson's system as Hitson teaches such content can be audio (at least paragraph 43) and Rosenberg teaches such information being another form of sound recordings, in addition to music, the user wants to hear information related to weather.

As per Claim 42, Hitson fails to explicitly teach without selection from the user device, automatically selecting an alert broadcast element selected from a group consisting of a weather alert broadcast element, a traffic alert broadcast element, and a stock price alert broadcast element based on the user profile; halting transmission of one of the plurality of broadcast elements to the user device prior to completion of the transmission of the one of the plurality of broadcast elements; and transmitting the alert broadcast element to the user device while the transmission of the one of the plurality of broadcast elements is halted. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Rosenberg. Rosenberg teaches a personalized audio channel having personalized information such as weather, stock quotes, etc (at least col. 4:63-5:3). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Rosenberg's weather/ stock quotes/ etc information with Hitson as this would enhance Hitson's system as Hitson teaches such content can be audio (at least paragraph 43) and Rosenberg teaches such information

being another form of sound recordings, in addition to music, the user wants to hear and be alerted and informed about.

Claims 50, 51, and 56 do not, in substance, add or define any additional limitations over claims 40 and 42 and therefore are rejected for similar reasons.

7. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hitson in view of Mackintosh et al (hereinafter "Mackintosh", 6,317,784).

Hitson fails to explicitly teach wherein automatically selecting the plurality of broadcast elements further comprises selecting a disc jockey introduction broadcast element, and mixing the disc jockey introduction broadcast element with the song broadcast element wherein the song broadcast element includes the disc jockey introduction broadcast element. However, the use and advantages for using such an audio element is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Mackintosh (at least col. 3, lines 1-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of DJ tracks being incorporated into Hitson's system as Hitson teaches such content can be audio (at least paragraph 43) and DJ commentary is simply another form of audio content to be streamed as well known in the radio broadcast arts.

Response to Arguments

8. Applicant's arguments filed 02 December 2008 have been fully considered but they are not persuasive.

With regard to the 101 Rejection, Applicant argues the computer-usable medium to be statutory. However, the specification on page 24, lines 5-8, specifically states that mediums are transmission, wired, wireless IP and communications media. In fact, *every* reference to the word media or medium in the specification (p. 2, 4, 5, 6, 13, 23) is preceded by 'transmission', with transmission media not being statutory.

With regard to the 102 Rejection of claim 39 in view of Hitson. Applicant argues Hitson fails to teach a list identifying at least a portion of broadcast elements previously transmitted to a user device (rather than user feedback or ratings) being used to select a plurality of broadcast elements to transmit to the user device. However, such argument is not persuasive. Hitson clearly teaches a user being sent a playlist/ list (at least paragraph 137, 139) and using that playlist, generating another playlist 'based on' the previously transmitted playlist. Hitson uses the pervious playlist along with feedback and ratings of content in that previous playlist to generate a new playlist. The current specification similarly teaches collaborative filtering processes using user feedback of songs to select future content (p. 21:6-25).

With regard to claims 43, 44, Hitson teaches users indicating preferences for various content genres when configuring an account (at least paragraph 151-153). Such user rules allowing for restriction of ratios of new content to old and tolerance for other genre/ type of content. While Applicant may suggest types of content as being songs,

advertisements, etc., such types are not specified by the claims. The content genres as Hitson teaches can include genres of music types or genres of content providers, including advertisers or other content creators (at least paragraph 153). Hitson further teaches users having a My Station on a registered home page (at least paragraph 75-76, 61, 69-70). The claim language interpreted broadly as including 'a reference to a name of the user', such 'reference' being associated with the user's personal home page. Examiner again respectfully points out that Applicant's claim terminology is much broader than the 'jingles' and audio elements saying 'Fred' that Applicant suggests the claims as teaching.

With regard to claim 42, Hitson clearly teaches streaming content to the user as well as content being 'pushed' from the server to the client (at least paragraph 9, 44). Rosenberg teaches a personalized audio channel wherein users specify content they are interested in to include weather, stock quotes, sports news, etc (at least col. 4:49-5:3), but the user has no direct control over the content. It would be obvious to one of ordinary skill in the art that such content qualifies as 'alerts' and without the user controlling the content, the content is automatically sent to them based on their interests, and it would be obvious that such time-sensitive content would be transmitted/pushed to the user in a time-sensitive manner before another song is streamed or pushed to the user. It is further noted that the claim language does not suggest the playback as being halter, but rather only the streaming/ transmission of such content, as such Hitson in view of Rosenberg teaches the claims as amended.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Root et al (col. 6:5-18; automatic custom weather service delivery alerts), in addition to previously cited Drosset et al, Herz et al, Chen et al (par. 41-43; profile subsystem automatically controlling selector for may element types), Bates et al (automatic audio broadcast selection), Cliff (automatic compilation of songs), Rosenburg et al, Srinivasan et al, Lotspiech et al, and Rouchon are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art references for relevant teachings when responding to this office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY G. TODD whose telephone number is

(571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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